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JAN 26 2012
OFFICE OF PETITIONS

In re Patent No. 6,530,905 :
Issue Date: March 11, 2003 : DECISION ON PETITION
Application No. 09/775,239 :
Filed: February 1, 2001 :
Patentee: Hoomana Asbaghi :

This is a decision on the petition under 37 CFR 1.378(b), filed January 4, 2012, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) is **DISMISSED**.

The above-identified patent issued March 11, 2003. Accordingly, the first maintenance fee could have been paid during the period from March 11, 2006 through September 11, 2006 without surcharge, or with a late payment surcharge during the period from September 12, 2006 through March 11, 2007. No maintenance fee having been received, the patent expired on March 12, 2007.

Applicable Rule, Case Law, Facts, and Analysis:

37 CFR 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in 37 CFR 1.20(e) through (g);
- (2) The surcharge set forth in 37 CFR 1.20(i)(1); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The instant petition does not meet requirement (3) above.

With regard to requirement (3), acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 USC 133. **This is a very stringent standard.** Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account."

Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

Here, petitioner sets forth the following facts in support of his assertion of unavoidable delay. According to petitioner, Nydegger and Associates (hereinafter "Nydegger"), the firm who prosecuted the application, sent a letter to the Patentee on August 1, 2006, reminding Patentee of the requirement to pay the maintenance fee. The letter contained a space at the bottom for Patentee to provide his instructions. Patentee could either place a check mark by the line that read "Please pay the maintenance fee" or could place a check mark by the line that

read "Please do not pay the maintenance fee and allow this case to go abandoned". On August 14, 2006, Nydegger received the letter back from Patentee, with a check mark by the line that read "Please do not pay the maintenance fee and allow this case to go abandoned."

As such, Nydegger did not pay the maintenance fee, and the patent expired on March 12, 2007. No further action was taken with respect to his patent by either Nydegger or the Patentee until September 16, 2011. On that date, the Patentee called Nydegger to inquire about a related European patent for the same invention. Nydegger provided Patentee with a copy of the August 14, 2006 letter, showing that Patentee had checked the box instructing Nydegger not to pay the maintenance fee. At that point, the Patentee claimed that he had checked the wrong box when responding to Nydegger, and has included a statement affirming such with the instant petition. The statement asserts that English is not the Patentee's first language.

Here, the failure to check the correct box and provide instructions for Nydegger to pay the maintenance fee, while arguably unintentional, was not unavoidable within the meaning of 37 CFR 1.378(b). Rather, the error is one that could have been avoided with the reasonable exercise of due care. Moreover, the lack of any billing from Nydegger to Patentee for payment of the first maintenance fee would have prompted a prudent and careful person to make inquiry of Nydegger sooner than September 16, 2011, a period of nearly 3 years after the maintenance fee letter was sent.

Conclusion:

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in §1.17(f). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay.

If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then \$2,690 submitted for the maintenance fee and the surcharge set forth in §1.20(i) are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing

such a petition for reconsideration, if none is filed. Petitioner may request a refund of the maintenance fee and surcharge by writing to: Mail Stop 16, Director of the USPTO, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of the last decision rendered should accompany the request for refund. The \$400 fee for requesting reconsideration is not subject to refund.

Further correspondence should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (571)273-8300
 Attn: Office of Petitions

Telephone inquiries specific to this decision may be directed to the undersigned at (571)272-3207.



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